

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CLAUS E. SADLIER,  
and GREGORY A. RODRIQUES

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Appeal No. 99-0838  
Application 29/064,666<sup>1</sup>

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ON BRIEF

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Before COHEN, MEISTER and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:

The Ornamental design for a Lid For Drinking Cup, as shown.

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<sup>1</sup> Application for patent filed January 8, 1997.

The invention is directed to the ornamental design for a lid for a drinking cup. As may be seen best from Figures 1, 2, 5, 6 and 7, the lid is a circular cup lid having a flat, circular horizontal center portion surrounded by a three-part raised circular wall or parapet. The outer surface of the raised circular wall or parapet extends downwardly below the circular center portion to form a generally circular main outside wall. A rounded shoulder portion extends outwardly and downwardly from the base of the main wall and a flared second wall extends downwardly and outwardly from the base of the shoulder portion. A planar circular flange extends radially outwardly from the terminal edge of the flared second wall. The raised circular wall or parapet of the cup lid has an upper surface that has three distinct sections: a semicircular, flat, horizontal portion that takes about half of the circle, an upwardly sloping portion that is also flat, and a chordlike portion that is flat, horizontal, and has a drinking aperture therein.

The references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Lid sold by Imperial Bondwear Corp., document “AW” in appellants’ Information Disclosure Statement filed May 7, 1997 (Imperial)

Lid sold by the Sweetheart Cup Company, document “AV” in appellants’ Information Disclosure Statement filed May 7, 1997 (Sweetheart)

The appealed design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Imperial in view of Sweetheart. According to the examiner

“[T]he Sweetheart lid teaches that it would have been obvious to a designer of ordinary capability in the art at the time the invention was made to modify the parapet walls of the Imperial lid by changing their continuous slope to a combination of sloping on one half of the lid, and level on the other half” (answer, page 4).

Other differences, such as the flat circular center section of the claimed lid, the planar lower flange and the squaring of the outer upper corners of the parapet wall have been characterized by the examiner as being de minimis and not sufficient to patentably distinguish the overall appearance of the claimed design from the lid resulting from the combination of the Imperial lid and the Sweetheart lid.

Reference is made to the examiner's answer (Paper No. 8, mailed August 19, 1998) for the examiner's complete reasoning in support of the above-noted rejection. Attention is directed to appellants' brief (Paper No. 7, filed May 5, 1998) and reply brief (Paper No. 9, filed October 23, 1998) for a full exposition of appellants' arguments thereagainst.

OPINION

Having carefully considered the issues raised in this appeal in light of the applied prior art, the examiner's remarks and appellants' arguments, it is our conclusion that the examiner's rejection of the present design claim under 35 U.S.C. § 103 is not sustainable. Our reasons for this determination follow.

In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration. See In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). Where the inquiry is to be made under 35 U.S.C. § 103, the proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. See In re Nalbandian, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981). Furthermore, as a starting point when a § 103 rejection is based upon a combination of references, there must be a reference, a "something in existence," the design characteristics of which are basically the same as the claimed design. Once a reference meets the test of a basic design reference, ornamental features may reasonably be interchanged with or added from those in other pertinent

references, when such references are "so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." See In re Rosen, *supra*; In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). If, however, the combined teachings of the applied references suggest only components of the claimed design, but not its overall appearance, an obviousness rejection is inappropriate. See In re Cho, 813 F.2d 378, 1 USPQ2d 1662 (Fed. Cir. 1987).

In the present case, appellants have challenged the examiner's determination that the lid of Imperial is a Rosen-type reference. In fact, it is appellants' position that neither of the applied references satisfy the Rosen requirement for a basic design reference. Appellants further argue that the prior art references relied upon by the examiner do not reasonably suggest the modification of the lid of Imperial as proposed by the examiner, and that, even if the references were combined as proposed, the resulting cup lid would not render obvious the claimed design considered as a whole. Appellants also point to a declaration by one of the inventors, Claus E. Sadlier, as providing evidence of commercial success of the claimed cup lid.

After a careful review, we find that we are in agreement with the examiner's position that the Imperial lid meets the requirements of a Rosen-type reference and constitutes a "something in existence"

the design characteristics of which are basically the same as the claimed design. Where we part company with the examiner is in the conclusion that the Sweetheart lid design would have been suggestive to the designer of ordinary skill in the art of modifications of the Imperial lid necessary to arrive at a cup lid that looks like the cup lid claimed by appellants. More particularly, we do not agree with the examiner that the Sweetheart lid would have been suggestive of changing the continuous slope of the parapet wall on the Imperial lid to “a combination of sloping on one half of the lid, and level on the other half” (answer, page 4).

In this regard, we agree with the arguments made by appellants on pages 2, 3 and 4 of their reply brief, that even if one were to attempt to combine Sweetheart’s teachings with those of Imperial, one would not come up with appellants’ claimed cup lid with its distinctive three-part upstanding parapet wall. Simply stated, appellants’ completely surrounding upstanding parapet wall with three distinctly different sections (i.e., a small horizontal-upper flat drinking aperture section, a sloping-middle section and a large horizontal-lower flat section) is not taught or suggested either singly or in any possible combination of the Imperial lid and the Sweetheart lid. Like appellants, we observe that neither of the applied references shows or suggests a cup lid that includes a parapet wall with any level section whatsoever. The completely surrounding parapet wall of the Imperial lid appears to slope smoothly and continuously across the entire lid, while the upstanding wall portion of the Sweetheart lid

carrying the drinking aperture slopes about 1/3+ of the lid and the remaining portion of the lid has no parapet wall at all.

In the final analysis, we are of the opinion that the collective teachings of the Imperial lid and the Sweetheart lid would not have led the designer of ordinary skill in the art to modifications of the Imperial lid which would have resulted in a cup lid having an overall appearance and creating a visual impression like that of the lid design claimed by appellants. It is our view that the evidence before us considered as a whole would simply not have been suggestive of the distinct ornamental appearance of appellants' claimed cup lid design. For that reason, we will not sustain the examiner's rejection of appellants' design claim under 35 U.S.C. § 103.

Since we have determined that the examiner has failed to establish a prima facie case of obviousness with regard to the claimed design, we find it unnecessary to consider appellants' evidence of secondary considerations relating to commercial success.

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Application 29/064,666

In accordance with the foregoing, the decision of the examiner rejecting the claimed design under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

JAMES M. MEISTER  
Administrative Patent Judge

CHARLES E. FRANKFORT  
Administrative Patent Judge

# BOARD OF PATENT APPEALS AND INTERFERENCES



Appeal No. 99-0838  
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